REMARKS/ARGUMENTS

Currently, claims 1-34 and 36-49 are pending, and claim 35 is canceled. Claims 1, 36, 48, and 49 are currently amended, and such amendments are fully supported by the specification and drawings. Claims 1-34 and 36-49 stand rejected as covering unpatentable subject matter and as being anticipated. Examiner's rejections are addressed in turn.

Rejection under 35 U.S.C. § 101

Claims 1-49 were rejected under 35 U.S.C.§ 101 as being directed to non-statutory subject matter for failure to be limited to the technological arts. In light of the amendments to independent claims 1, 48, and 49, this rejection is now moot.

Rejection under 35 U.S.C. § 102

Claims 1-7, 9, 11, 14-16, 18-21, 23-24, 25-32, 36-37 and 39-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (5,976,082). Wong fails to teach each and every element of every claim as required by MPEP § 2131, and for at least this reason the § 102 rejection is unsupported by the art.

The present invention as claimed requires computing "a plurality of scores...for each of a plurality of members in a health plan." Unlike the present claimed invention, Wong only analyzes a subset of the members in a health plan. The method of the Wong reference is practiced exclusively in the context of a single disease, namely congestive heart failure, and provides analysis only for those patients with CHF. Wong identifies CHF patients from the set of patients in a health plan and extracts the CHF patients (step 116) prior to performing analysis (step 124) and statistical processing, or determining individuals' probability (p) value. Col. 3, lines 49-51; col.6, lines 61-67; col. 7, lines 1-21; col. 14, line 60-col. 15, line 14. Because Wong extracts CHF patients from a set of health plan members and calculates a probability (p) for only that subset of patients, the reference does not disclose or suggest computing a score for each of the plurality of members in a health plan as in claim 1.

Additionally, Wong relates to identifying at risk CHF patients, but the reference does not disclose or suggest predicting a consumption level of healthcare resources by a healthcare plan

member as recited in claim 1. Examiner counters, "Wong discloses the variables in the model for prediction including those 'which best reflect a correlation to adverse health outcomes, consequently, resulting in substantial use of health care resources (e.g. funds)' (col. 5 lines 18-25)." However, this teaching of Wong is still a computation determining at risk congestive heart failure patents; it does not disclose predicting a consumption level of healthcare resources. A "substantial" use of healthcare resources described in Wong does not teach predicting the "level" of healthcare consumption by a plan member as claimed.

For at least these reasons, Wong does not anticipate claim 1. Because claims 2-7, 9, 11, 14-16, 18-21, 23-24, 25-32, 36-37 and 39-46 depend from claim 1 and incorporate the elements of claim 1, claims -7, 9, 11, 14-16, 18-21, 23-24, 25-32, 36-37 and 39-46 are also not anticipated by Wong.

Claims 48-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Whiting-O'Keefe. Whiting-O'Keefe fails to teach each and every element of every claim as required by MPEP § 2131, and for at least this reason, the § 102 rejection is unsupported by the art.

Claim 48 recites "computing a score...wherein the act of computing comprises computing a burden of illness" and "using the score to predict healthcare resource consumption by the plan member." The cited reference fails to teach both computing a score and predicting healthcare resource consumption. Whiting-O'Keefe discloses "estimating likely charges (expenditure of resources) for treating a given patient" and "estimating the financial burden for each illness within each patient..." Col. 2, lines 22-30. Specifically, to estimate a patient's charges for illness treatment, the method of Whiting-O'Keefe solves a series of equations that result in a patient's expected charges (step 139). Col. 12, lines 6-16. Nowhere, however, does the reference disclose both computing a score *and* predicting a consumption using that score as claimed.

Claim 49 recites "using the score to identify plan members to whom preventive measures are recommended." For the same reasons described above, Whiting-O'Keefe fails to disclose computing a score. Additionally, Whiting-O'Keefe also fails to disclose any preventive measures as claimed in claim 49. Indeed, the teaching of Whiting-O'Keefe is intended to

facilitate estimating likely treatment charges by reducing variations in estimated outcomes of treatment, col. 2, lines 33-51, not to "reduce consumption of healthcare resources" with preventive measures as claimed.

Rejection under 35 U.S.C. § 103

Claims 8, 10, 12-13, 17, 38 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong et al. (5,976,082) as applied to claim 1; claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong et al. (5,976,082) as applied to claim 1, and further in view of Mohlenbrock et al. (5,018,067); and claims 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong et al. (5,976,082) as applied to claim 1, and further in view of Lockwood (5,706,441).

Because these dependent claims depend from claim 1 and incorporate the elements of claim 1, for the reasons above these dependent claims are not anticipated or made obvious.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP
Customer Number 25763

Date: February 22, 2005

By: _____
Devan V. Padmanabhan, Reg. No. 38,262
Intellectual Property Department
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498
(612) 340-7990